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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,447	06/28/2001	Franklin W. Dabby	263/203	5193

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HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

FIORILLA, CHRISTOPHER A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/894,447	Applicant(s) DABBY ET AL.	
	Examiner Christopher A. Fiorilla	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11, 22, 27-35, 44 and 51 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 11, 22, 28-35, 44 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/30/02 5/15/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of Group I, species a in Paper dated 1/2/04 is acknowledged. The traversal is on the ground(s) that:

- the apparatus claims cannot be used to practice another materially different process such as one that produces non-silica material because each of these apparatus claims in Group I includes the limitation of "depositing silica";
- the apparatus claims cannot be used to make a different product such as a non-silica based product. The recitation of "depositing silica requires that the apparatus claims produce a silica-based product;
- the Office Action does not explain how the example provided of a materially different process used to manufacture the product as claimed is in fact materially different from the claimed process;
- the groups defined in the office action would likely require the Examiner to search the same subclasses and consider the same prior art references thus examination of all claims together would not place a serious burden upon the examiner;
- the examination of all of the pending Deposition System species claims will not place a serious burden upon the examiner;
- the office action does not include any reasons for insisting upon restriction between the species

This is not found persuasive because:

- the recitation of "depositing silica particles" in the preamble of e.g. claim 1 does not mean that the apparatus cannot be used to carry out another materially different process such as one that produces non-silica material or to produce another and materially

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different product because the claim is an apparatus claim (not a use claim) and thus this method limitation does not limit potential uses for the apparatus

- the example given for another and materially different process was a poor example of a materially different process, the examiner maintains that the products as claimed can be made by another and materially different process such as one wherein the rod is rotated or translated as set forth in the claims. Rather, the deposition apparatus can be rotated and translated about the rod.
- although the search for certain groups/species may overlap, a thorough search for each group/specie would involve unique search areas and considerations thus a serious burden would exist in examining multiple groups and/or species;
- the reason, as set forth in the previous office action, is that the species are patentably distinct. As mentioned above, a search for all multiple species would cause serious burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7,8,11,22,28-35,44-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and/or invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper dated January 2, 2004. Note that claims 28 is a product claim and has been grouped with the product claims and withdrawn from consideration.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it contains language which may be implied (i.e. "...is disclosed"). Correction is required. See MPEP § 608.01(b).

5. The use of the trademarks Hasteloy (e.g. page 17) and Hepa (e.g. page 15) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. Claims 1-7 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 8, the phrase "lathe is for at times" is confusing.

Claim 3 contains the trademark/trade name Hasteloy. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim

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does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a material and, accordingly, the identification/description is indefinite.

7. Claims 1-7 and 27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an apparatus which utilizes a specific translation speed included in a specific motion profile to reduce unusable portions at the ends of the workpiece (see e.g. pages 29-30 of the specification), does not reasonably provide enablement for the apparatus as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1,2,5,6 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkar (5,558,693).

Sarkar teaches the basic claimed system. The system disclosed by Sarkar includes: a burner, a lathe and computer for controlling translating and rotating. Sarkar also discloses a casing with vents (i.e. each side of the butterfly valve, 24).

Note that claims 5 and 6 recite process limitations and thus do not limit the apparatus, per se.

Sarkar does not specifically disclose that the transverse mechanism is for speeds of greater than about 1.4 meters per minute.

It is well known in the art to translate apparatus components at the claimed speeds and accelerations. It would have been obvious to one skilled in the art at the time of the invention to use componets to achieve the desired speed and acceleration.

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11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkar as applied to claims 1,2,5,6 and 27 above, and further in view of Sanghera et al.

Sanghera discloses a deposition chamber made from Hasteloy (col. 10, line 12). It would have been obvious to one skilled in the art to make the casing of Sarkar from this material in view of the generic disclosure of Sarkar and the properties of the material and advantages as disclosed by Sanghera.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is (571) 272-1187. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher A. Fiorilla
Primary Examiner
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